



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,702	03/09/2001	Zai-Ming Qiu	55907USA7A.003	6330
32692	7590	05/05/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			OH, TAYLOR V	
PO BOX 33427				
ST. PAUL, MN 55133-3427			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/803,702

**Applicant(s)**

QIU ET AL.

**Examiner**

Taylor Victor Oh

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10 is/are rejected.
- 7) ☒ Claim(s) 5-9 and 11-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The finality of the previous Office Action has been withdrawn. The application is reopened due to a new ground of rejection.

The Status of Claims :

Claims 1-19 are pending.

Claims 1-4 and 10 have been rejected.

Claims 5-9 and 11-19 have been objected.

1. claims 1-19 are under consideration.

Priority

2. None.

Drawing

3. None.

***Claim Objections***

Claims 5-9 and 11-19 are objected to as being dependent upon a rejected base claim.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 4, 8-10, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "one or more fluorinated polyols" and "one or more polyisocyanates" are recited. These expressions are vague and indefinite because there are so many kinds of polyols and polyisocyanates in the art ; particularly, for fluorinated polyols , according to the specification, there are N-bis(2-hydroxyethyl)perfluorobutylsulfonamide, fluorinated oxetane polyols, 1,4-bis(1-hydroxy-1,1-dihydroperfluoropropoxy)perfluoro-n-butane, and etc. Furthermore, as for polyisocyanates, there are tetramethylene 1,4-diisocyanate, hexamethylene 1,4-diisocyanate, hexamethylene 1,6-diisocyanate, octamethylene 1,8-diisocyanate, 1, 12-diisocyanatododecane, and etc. The expression of "one or more fluorinated polyols" and "one or more polyisocyanates" lacks the description of what kinds of polyols and polyisocyanates are involved in the composition. Therefore, an appropriate correction is required.

In claim 1 , the phrase "one or more oligomers comprising" , " compounds or oligomers comprising" , and " compounds comprising " are recited. The expression of the word "comprising" would mean that there are additional components besides compounds or oligomers. Therefore, an appropriate correction is required.

In claims 2 and 4, the phrase "the oligomers of claim 1 further comprising" , " compounds comprising" are recited. The expression of the word "comprising" would

mean that there are additional components besides compounds or oligomers.

Therefore, an appropriate correction is required.

In claim 8 , the phrase " the oligomers of claim 1 comprising" is recited. The expression of the word "comprising" would mean that there are additional components besides the oligomers. Therefore, an appropriate correction is required.

In claims 9 and 10 , the phrase " the oligomer comprises" is recited. The expression of the word "comprises" would mean that there are additional components besides the oligomer. Therefore, an appropriate correction is required.

In claim 16 , the phrase " said fluorochemical oligomer further comprises" is recited. The expression of the word "comprises" would mean that there are additional components besides the oligomer. Therefore, an appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Smith et al (WO 93/01349).

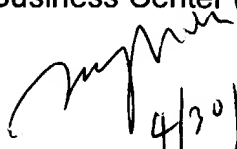
Smith et al discloses fluorochemical compositions comprise a fluorinated acrylate monomer, polyalkylene glycol acrylate, a polyalkoxylated polyurethane having pendant perfluoroalkyl groups containing polyisocyanates, and a fluorinated alcohol , and etc. (see page 14, 1-15). This is identical with the claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mckane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

\*\*\*

  
4/30/24



BA K. TRINH  
PRIMARY EXAMINER  
GROUP 1200/1625